

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

HENRICSON et al

Serial No. **08/875,424**

Filed: **July 28, 1997**

For: **METHOD OF PRETREATING PULP TO BE BLEACHED
WITH PEROXIDE**



Atty. Ref.: **30-440**

Group: **1731**

Examiner: **Alvo**

Handwritten initials/signature

December 10, 1999

Assistant Commissioner for Patents
Washington, DC 20231

RECEIVED

Sir:

DEC 15 1999

**PETITION FOR REVIEW OF THE PROPRIETY
OF THE ISSUING OF THE SECOND
NOTICE OF NON-COMPLIANCE**

OFFICE OF PETITIONS
DEPUTY A/C PATENTS

Since the August 23, 1999 Response was not -- as specifically requested therein -- treated as a petition of review of the propriety of the issuance of the Notification of Non-Compliance, this paper is being filed specifically as a petition for the review of the propriety of the second Notification of Non-Compliance with the requirements of 37 CFR 1.192(c). It is believed that no fee is due for this petition, but if one is in fact due the Patent & Trademark Office is authorized to charge Account No. 14-1140, Our Order No. 30-440.

The Final Rejection in this case gives shotgun rejections that do not specifically mention or deal with the limitations of the vast majority of the claims. Yet despite this completely failure of the Examiner to discharge his responsibility pursuant to *In re*

Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177-78 (CCPA 1967) appellants are

criticized for not giving any reasons why each of the claims in the shotgun rejections are

12/22/1999 BMURPHY 00000006 141140 08875424

different over the applied art. In fact the Examiner's position in this regard is completely

CEASED

erroneous, and this is a matter for the Board to determine whether appellants' arguments are sufficient in that regard.

Appellants have not merely pointed out differences in what the claims cover as alleged by the Examiner. Appellants have pointed out that none of the feature of the dependent claims at issue are shown in the prior art references, and has also specifically stated:

"Further there simply is no suggestion within any reference as to why anyone of ordinary skill would modify the references to teach these features, and therefore clearly no *prima facie* case of obviousness. The PTO has not discharged its duty to prove a *prima facie* case by facts with respect to any of these claims. Therefore all of the claims clearly patentably distinguish from the art."

While the Examiner may not be convinced that he has the responsibility to establish a *prima facie* case of obviousness and therefore he himself must put forth reasons why there is a suggestion within the references to modify them to provide the invention, that is something for the Board to decide. The Examiner cannot under the guise of a formality objection attempt to short-circuit substantive consideration of the claims by the Board.

On page 4 of the Notification of Non-Compliance in the first sentence after quoting the rules it is stated that "Applicant does not include claims 36-46 under "ISSUES" and thus does not comply with paragraph 6 above." This is clearly wrong. On page 4 of the August 23, 1999 Brief under the heading "VI. ISSUES" is listed "Is the 'phantom' rejection of claims 36 through 46 appropriate?"

Enclosed herewith are three copies of a revised Appeal Brief specifically responding to the supplemental rejection of the claims in the paragraph bridging pages

1 and 2 of the Notification of Non-Compliance dated November 15, 1999. While it is was inappropriate for the Patent & Trademark Office to insert these new rejections of the claims in a paper supposedly dealing with formalities, rather than argue this point appellants have simply argued those new rejections in the new enclosed Revised Appeal Brief.

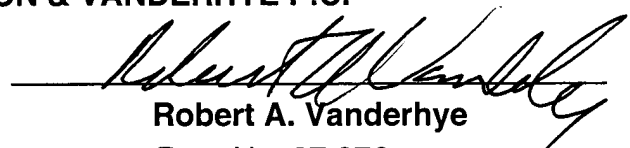
By issuing the two Notifications of Non-Compliance the Examiner has delayed substantive consideration of this case for more than seven months. This is time that the appellants will never get back as far as enforceability of the patent is concerned because it is not during the time that the case has been submitted to the Board of Appeals. Therefore, it is necessary for this petition to be decided by the Group Director or whomever else is discharged with the responsibility of deciding petitions of this nature so that further delay to appellants detriment will not be occasioned.

Early grant of this Petition is respectfully requested.

Respectfully submitted,

NIXON & VANDERHYE P.C.

By:


Robert A. Vanderhye
Reg. No. 27,076



RAV:Imy

1100 North Glebe Road, 8th Floor
Arlington, VA 22201-4714
Telephone: (703) 816-4000
Facsimile: (703) 816-4100

TO 1700 MAIL ROOM
DEC 17 1999
RECEIVED